

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/674,877	01/02/01	HOEFLER	G 2727-127

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EXAMINER

AULAKH, C

ART UNIT	PAPER NUMBER
1625	6

DATE MAILED: 08/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/674,877	Applicant(s) Hoefle, G. et al.
	Examiner CHARANJIT AULAKH	Art Unit 1625
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
1) <input type="checkbox"/> Responsive to communication(s) filed on _____.		
2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>1-17</u> is/are pending in the application.		
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>1-17</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.		
Application Papers		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. § 119		
13) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).		
a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:		
1. <input type="checkbox"/> Certified copies of the priority documents have been received.		
2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.		
3. <input checked="" type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
*See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).		
Attachment(s)		
15) <input type="checkbox"/> Notice of References Cited (PTO-892)		
16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____		
18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
20) <input type="checkbox"/> Other: _____		

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DETAILED ACTION

1. According to a preliminary amendment (paper no. 5), filed on Jan. 2, 2001, the applicants have amended claims 6-12, 14, 15 and 17.
2. Claims 1-17 are now pending in the application.

Claim Objections

3. Claims 9-14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in alternative only. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 6-16, the term " characterized in " is vague. The applicants are suggested to use the term " wherein ".

In claims 1-17, when x-y represents -CH₂CH-OP, it is not clear what is connected to the C(CH₃)₂C=O group. Is it O or CH ?

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In claim 2 and 9-11, it is not clear what is meant by B in in formula (3). Is it boron?

In claim 3, it is not clear whether Hal refers to only Br and I or Br and I are the preffered halogens since Cl and F are other known halogens.

In claims 9-14, the term " production " is vague. The applicants are suggested to use the term " preparation or preparing "

In claims 15-17, the terms " tharapeutic agent and plant protecting agent " are vague and indefinite since it is not clear what is the intended purpose ? It seems that the claims are directed to a pharmaceutical composition comprising compounds of claim 1. The applicants are suggested to direct the claims to pharmaceutical compositions or to a method of treating a particular disease state in a subject or as a herbicidal or pesticidal activity in case of protecting plants comprising administering a therapeutically effective amount of compounds of claim 1.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 4, 5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nicolaou (Chem.--Eur. J. 3(12) 1971-1986, 1997, cited in the international search report).

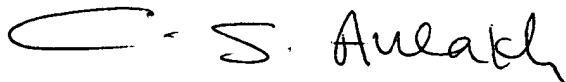
Nicolaou discloses total synthesis of oxazole- and cyclopropane-containing epothilone B analogues by the macrolactonization approach. The compounds no. 2 and 30-32 (see page 1973) disclosed by Nicolaou anticipate the instant claims when X-Y represent CH₂CHOP and R₂ represents a monocyclic heteroaryl group in the instant compounds of formula (6).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chana Aulakh whose telephone number is (703) 305-4482. The examiner can normally be reached on "Monday-Thursday" from 7:30 A.M. to 6:00 P.M.

If the attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Jyothsna Venkat, can be reached on (703) 308-2439. The fax number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group's receptionist whose telephone number is (703) 308-1235.


CHARANJIT S. AULAKH

PRIMARY EXAMINER